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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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BASF CORPORATION  
ANNE GERRY SABOURIN  
26701 TELEGRAPH ROAD  
SOUTHFIELD, MI 48034-2442

EXAMINER

ZALUKAEVA, TATYANA

ART UNIT	PAPER NUMBER
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DATE MAILED: 08/28/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/965,423

Applicant(s)

RIHAN ET AL.

Examiner

Tatyana Zalukaeva

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 27 September 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other:

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-21 are rejected under 35 U.S.C. 102(b) as being anticipated by Rink et al (U.S. 5,759,631).

Rink discloses a refinish clear coating composition comprising

(A) at least one hydroxyl group-containing polyacrylate resin obtained by polymerizing

(a) from **5 to 80% by weight of a cycloaliphatic ester** of methacrylic acid and/or acrylic acid, or a mixture of such monomers,

(b) from **10 to 50% by weight of a hydroxyl group-containing alkyl ester of methacrylic acid and/or acrylic acid, or mixtures of such monomers,**

(c) from 0 to 25% by weight of a hydroxyl group-containing, ethylenically unsaturated monomer, different from (a) and (b),

or a mixture of such monomers,

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(d) from 5 to 80% by weight of an aliphatic ester of methacrylic and/or acrylic acid, different from (a)-(c), or a mixture of such monomers,

(e) from 0 to 40% by weight of an aromatic vinyl hydrocarbon, different from (a)-(d), or a mixture of such monomers, and

(f) from 0 to 40% by weight of an additional ethylenically unsaturated monomer, different from (a)-(e), or a mixture of such monomers, and

(B) at least one crosslinking agent. (see abstract).

The number average molecular weight is 1000 –5000 (column 2, lines 20-25). Weight average  $M_w = M_n \times \text{polydispersity}$ , which is said to be lower than 5 (column 2, line 23) , preferably from 1.8 to 4 (column 3, lines 16-20). Thus inherently  $M_w = 5,000 \times 4 = 20,000$ , which satisfies the limitations of claims 1 and 5. The hydroxyl number of a polymer is 60-180 mg of KOH/g, which meets the limitation of the instant claim 9.

Monomers (d) and (e) described in column 5, lines 25-43 staidfy the requirements of claim 10.

With specific regard to claims 18 and 19 Rink discloses that a coating composition employs crosslinking agent (B), which is selected from the group consisting of at least one **diisocyanate, polyisocyanate which contains isocyanurate** groups, and mixtures thereof. (see claim 11).

With regard to the process of coating Rink discloses the process summarized in claim 12, which is the process of the instant claim. The clear coating composition of Rink is designed for VOLVO.

Therefore all the limitations of the instant claims are either explicitly or inherently met by the disclosure of Rink.

3. Claims 1-21 are rejected under 35 U.S.C. 102(b) as being anticipated by Rockrath et al (U.S. 5,716,678).

Rockrath discloses a clear coating composition and method of a production of two-coat finish on a substrate, a transparent lacquer composition containing a hydroxyl group-containing polyacrylate resin produced by polymerizing

**(a) 10 to 51%** by weight 4-hydroxy-n-butylacrylate or

4-hydroxy-n-butylmethacrylate or a mixture of 4-hydroxy-n-butylacrylate and 4-hydroxy-n-butylmethacrylate;

**(b) 0 to 36% by** weight of a hydroxyl group-containing ester of acrylic acid different from (a) or a hydroxyl group-containing ester of methacrylic acid or a mixture of such monomers;

**(c) 28 to 85% by weight of an aliphatic or cycloaliphatic ester** of

methacrylic acid different from (a) and (b) with at least 4 C atoms in the alcohol residue or a mixture of such monomers;

(d) 0 to 3% by weight of an ethylenically unsaturated carboxylic acid or a mixture of ethylenically unsaturated carboxylic acids and

(e) 0 to 20% by weight of an ethylenically unsaturated monomer different from (a), (b), (c) and (d) or a mixture

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of such monomers, into a polyacrylate resin with a hydroxyl number from 60 to 200 number average molecular weight from 1,500 to 10,000.(abstract). Component (b) is described in column 4, lines 28-40.

It is possible to employ a crosslinking compound (B), which are preferably derived from diisocyanates and contain isocyanurate groups (column 5, lines 49-56).

The process of refinishing substrate is disclosed in column 9, lines 40-53. Such steel panels coated with a commercial electro-deposition coating and a commercial filler are spray-coated with a commercial, nonaqueous basecoat which contains aluminum pigment, are dried for 5 minutes at room temperature and then are coated over with the transparent topcoats. After a further drying time of 5 minutes at room temperature, the basecoat and topcoat are baked together for 20 minutes at 140°C in a circulating-air oven. The resulting finishes are distinguished by a high degree of hardness, high gloss, good adhesion between basecoat and topcoat and good topcoat appearance.

With regard to the limitation of the instant claims of a viscosity expressed in Stokes it is a base presumption, that since the compositions of the instant claims and both Rockrath and Rink are identical and are made by essentially the same method, the properties even if not taught will be inherently the same. Products of identical chemical composition cannot have mutually exclusive properties. A chemical composition and its properties are inseparable. Therefore if the prior art teaches the identical chemical structure, the properties and characteristics applicant discloses and/or claims are necessarily present. In re Spada, 911 F.2d 705,709,15 USPQ2d 1655,1658 (Fed. Cir. 1990). Consult also In re Fitzgerald. In other words when the claimed compositions are

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not novel, they are not rendered patentable by recitation of properties, whether or not these properties are shown or suggested in prior art.

### ***Double Patenting***

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 1-21 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-23 of copending Application No. 09/850,837 and copending Application 09/886,742. Although the conflicting claims are not identical, they are not patentably distinct from each other because they both claim clear coating composition comprising identical ingredients wherein the ranges of those components overlap with the ranges as instantly claimed.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

6. The other prior art cited in PTOL-892 shows the general state of art.

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7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tatyana Zalukaeva whose telephone number is (703) 308-8819. The examiner can normally be reached on 9:00 - 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (703) 308-2450. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0651.

Tatyana Zalukaeva  
Examiner  
Art Unit 1713

August 15, 2002